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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/824,943	03/27/97	RODENBURGH	C 16958

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TIMOTHY J ABERLE
THE WHITAKER CORPORATION
4550 NEW LINDEN HILL ROAD
SUITE 450
WILMINGTON DE 19808

EXAMINER

BAUMGARDNER, C

ART UNIT
2786

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/824,943	Applicant(s) Rodenburgh et al.
	Examiner Carolyn T. Baumgardner	Group Art Unit 2786

Responsive to communication(s) filed on Jan 22, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-4 and 16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-4 and 16 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. The Response After Final Rejection filed on **January 22, 1999** has been entered and considered.

2. Claims **1-4** and **16** are presented for examination.

Claims **5-15** have been canceled.

Withdrawal of Final Rejection - new ground of rejection

3. The previous final rejection is withdrawn for the purpose of entering a new ground of rejection. A previously cited reference is now being applied to pending claims. Examiner regrets the delay in applying this reference. Due to the withdrawal of the final rejection, all amendments filed after the final rejection will ordinarily be entered.

Claims Allowed, Now Rejected, Newly Cited Art

4. The indicated allowability of claims **1-2** and **16** is withdrawn in view of the newly cited reference(s) to **Shah** (patent number 5,304,341). Rejections based on the newly cited reference(s) follow.

Claim Rejections under 35 U.S.C. 102

5. The rejection to claims **3-4** are withdrawn in light of the new grounds of rejection.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by **Shah (patent number 5,304,341)**.

As to independent claim 1, the reference **Shah** teaches a tooling assembly comprising:

- a. A product material inlet (e.g., see figure 1);
- b. A product material channel (e.g., see abstract and figure 3);
- c. A product cavity (e.g., see abstract);
- d. A flow path defined by the inlet, channel, and cavity (e.g., see figure 1);
- e. A flow device assembly (e.g., see col. 1 lines 7-11); and
- f. A flow device actuation assembly (e.g., see figure 3, elements 90 & 88).

As to independent claim 2, the reference **Shah** teaches a tooling assembly comprising:

- a. A product material inlet (e.g., see figure 1);
- b. First and second product material channels (e.g., see figure 3);

- c. First and second product cavities (e.g., see figures 1 & 3);
- d. A flow path defined by the inlet, first and second channels, and first and second product cavities (e.g., see figure 3);
- e. A plurality of flow device assemblies (e.g., see abstract); and
- f. A plurality of flow device actuation assemblies (e.g., see col. 4 lines 51-67).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 USC 103(a) as being unpatentable over **Shah** (patent number 5,304,341) in view of **Hendry** (patent number 5,728,410).

Shah discloses (1) flowing the product material in a flow path (e.g., see figure 3); (2) providing a flow channel (e.g., see figure 3); and (3) altering the posture of the flow channel with respect to the flow path (e.g., see figure 3, elements 90 & 88). However, **Shah** does not disclose expressly allowing the product material to solidify in the flow channel. **Hendry** discloses: (1)

[Handwritten mark: a large, stylized letter 'C' with a small circle at the top left.]

allowing the product material to solidify in the flow channel (e.g., see col. 2 lines 45-56); and (2) solidified material being offset with respect to the flow path (e.g., see col. 2 lines 42-56).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Shah by allowing the product material to solidify in the flow channel. The motivation for doing so would have been to produce a substantially stain-free article. Therefore, it would have been obvious to combine Hendry with Shah to obtain the invention as specified in claim 3.

10. Claim 16 is rejected under 35 USC 103(a) as being unpatentable over **Shah (patent number 5,304,341)**.

Shah discloses all of the limitations of claim 16 as noted above in the 102(b) rejection of claim 1. However, Shah does not expressly disclose a flow device actuation assembly that is rotatable to alter an angle of the flow channel. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Shah by incorporating a rotatable actuating assembly into the system instead of a linear device. The motivation for doing so would have been to allow for a greater range of flow channel variations.

Rejection, 35 U.S.C. 102 or 103(a)

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

12. Claim 4 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Hendry (patent number 5,728,410)**.

"Even though product - by- process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe , 227 USPQ 964, 966 (Fed. Cir. 1985).

"[T]he lack of physical description in a product - by - process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product - by - process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown , 173 USPQ 685, 688 (CCPA 1972).

As to dependent claim 4 the reference **Hendry** teaches:

- a. Producing a solidified product by a process (e.g., see abstract and col. 3 lines 1-12).

Response to Arguments

13. The arguments are moot in light of the new grounds of rejection.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Baumgardner, whose telephone number is (703) 306-4768. The examiner can normally be reached on M-F from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, William Grant, can be reached at (703) 308-1108. Additionally, the fax phone for Art Unit 2786 is (703) 308-9051 or 308-9052.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.



Carolyn T. Baumgardner

February 5, 1999



William Grant
Supervisory Patent Examiner
Art Unit 2786

